

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jun-ichi Nezu et al. Art Unit : 1647
Serial No. : 10/762,154 Examiner : Bridget E. Bunner
Filed : January 21, 2004 Conf. No. : 4898
Title : POLYNUCLEOTIDES ENCODING hOCTN1 POLYPEPTIDE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)

Applicants hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced application. Reconsideration of the PTA calculation to increase total PTA from 895 days to 925 days is respectfully requested.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

PTO Delay

A first PTO action was due on or before March 21, 2005 (the date that is fourteen months after January 21, 2004, the date on which the application was filed). The Office mailed the first non-final Office Action on January 10, 2006, thereby according a PTO Delay of 295 days. Applicants do not dispute the Office's calculation for this PTO Delay from March 22, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to January 10, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before June 23, 2007 (the date that is four months after February 23, 2007, the date on which a response to Office Action was filed). The PTO mailed a final Office Action on September 27, 2007, thereby according a PTO Delay of 96 days. Applicants do not dispute the PTO's calculation for this PTO Delay from June 24, 2007 (the day after the date that is four months after the date on which a response to Office Action was filed), to September 27, 2007. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

A Notice of Appeal was filed by Applicants on March 26, 2008. On April 13, 2010, the Office mailed a final Decision in favor of the Applicants ("Decision") by the Board of Patent Appeals and Interferences ("BPAI"), thereby according a PTO Delay of 749 days. Applicants do

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not dispute the Office's calculation for this PTO Delay from March 26, 2008, to April 13, 2010. See 37 C.F.R. §§ 1.702(e) and 1.703(e).

In view of the periods of PTO Delay detailed above, the total PTO Delay for this application should be calculated as 1,140 days (i.e., the sum of 295 days, 96 days, and 749 days).

Applicant Delay

A reply to an Office Action was due on or before April 10, 2006 (the date that is three months after January 10, 2006, the date on which the Office Action was mailed). Applicants filed a response to the Office Action on June 12, 2006, thereby according an Applicant Delay of 63 days. Applicants do not dispute the PTO's calculation for this Applicant Delay from April 11, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to June 12, 2006. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before November 23, 2006 (the date that is three months after August 23, 2006, the date on which the Office Action was mailed). Applicants filed a response to the Office Action on February 23, 2007, thereby according an Applicant Delay of 92 days. Applicants do not dispute the PTO's calculation for this Applicant Delay from November 24, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to February 23, 2007. See 37 C.F.R. § 1.704(b).

A response to a final Office Action was due on or before December 27, 2007 (the date that is three months after September 27, 2007, the date on which the final Office Action was mailed). Applicants filed a response to the final Office Action on February 25, 2008. Applicants filed a Notice of Appeal (with no further amendment or other response) on March 26, 2008. Applicants were accorded a delay of 90 days for this submission, ostensibly under 37 C.F.R. § 1.704(b), as the period of time between December 28, 2007 (the day after the date that is three months after September 27, 2007, the date on which the Office Action was mailed) and March 26, 2008 (the date on which the Notice of Appeal was filed) equals 90 days. Upon conclusion of the period of appellate review, the Office mailed a final Decision in favor of the Applicants by the Board of Patent Appeals and Interferences on April 13, 2010. Applicants respectfully submit that the filing of the response to the final Office Action on February 25, 2008, was, in fact, a complete and timely response to the outstanding final rejection

under 37 C.F.R. § 1.704(b), as no further amendment was made subsequent to its filing and prior to the mailing of the April 13, 2010, Decision by the BPAI. Therefore, Applicants respectfully request that the calculation of 90 days of Applicant Delay be decreased to 60 days. Id.

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this application should be calculated as 215 days (i.e., the sum of 63 days, 92 days, and 60 days).

Conclusion

In consideration of the events described above, Applicants believe the PTA calculation of 895 days is incorrect. Accordingly, Applicants respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,140 days (i.e., the sum of 295 days, 96 days, and 749 days);
- 2) Total Applicant Delay should be calculated as 215 days; and
- 3) Total PTA should be calculated as 925 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 14875-0057002.

Respectfully submitted,

Date: March 2, 2011

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